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10/799,048

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Shubhasheesh Anand

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EXAMINER

STIBLEY, MICHAEL R

ART UNIT

PAPER NUMBER

3688

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/799,048

**Applicant(s)**

ANAND ET AL.

**Examiner**

MICHAEL R. STIBLEY

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/25/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6, 8-10, 12, 13 and 29-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-6, 8-10, 12-13 and 29-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Request for Continued Examination**

1. Receipt is acknowledged of a request for continued examination, filed on 3/31/2009, under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on 3/31/2009. Prosecution is hereby re-opened, a detailed action follows:

### **Election/Restriction Requirement**

2. On 6/10/2009, Examiner issued a Restriction Requirement of the claims presented on 3/31/2009. Applicant elected group I, without traverse, namely claims 1-3, 5-6, 8-10, 12-13 and 29-36 which are currently pending and have been examined. Applicant has cancelled non-elected claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 5-6, 8-10, 12-13 and 29-36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to Claims 1 and 8 of which claims 2-3, 5-6, 7-10, 12-13 and 29-36 depend, Examiner considers the claims unclear because of the following limitations for both the method and computer readable storage medium claims:

wherein the second contract is associated with a behindness value that is currently greater than a behindness value associated with the first contract;

wherein the behindness value of each contract reflects how far behind a content provider is on satisfying the delivery obligations associated with each contract

selecting the first advertisement from the second subset of advertisements to include in the slot based, at least in part, on the potential revenue amounts;

These limitations are unclear because while a behindness value is provided for, it is not actually used to advance the method. The final selection of the advertisement is based on potential revenue amounts and is in no way related to behindness value so thus the purpose and how the behindness value comes into play is unclear and uncertain. Appropriate action is required.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-3, 5-6, 8-10, 12-13 and 29-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shamin Naqvi et al (NAQVI)(WO 97/21183) in view of Russell C. Horowitz et al (HOROWITZ)(US 2005/0149396 A1).

As per Claims 1 and 8: NAQVI teaches: A computer-implemented method for determining which advertisements to include with electronic content delivered to users over a network, the method comprising the steps of:

See at least "...the content page is provided by a home page dispatcher, a search engine, or a generic HTML content provider in response to the query..." Page 9 lines 25-30

after accepting a first contract with a first advertiser, accepting a second contract with a second advertiser;

See at least abstract "...the system uses contracts..."; "...set of contracts that were accepted when advertisers placed their advertisements with the system..." Pg 16 lines 20-32 [the system accepts multiple contracts from multiple advertisers at different times]

wherein the delivery obligations associated with the second contract are such that fulfillment of the second contract would adversely affect a level of service the first advertiser would otherwise receive under the first contract;

See at least "...this type of contract can be used to guarantee that an advertiser's ad is not shown at the same time or on the same page as a competitor's advertisement..." Pg 18 lines 5-12 [a competitor's contract would adversely affect level of service to another competitor's- also, the ability to exclude the competitor's ads, this is also an adverse effect]

See also pg 16 line 25- 17 line 7- another advertiser's contract will adversely effect the delivery of a first advertiser as there is only so much advertising space that is used.

receiving a plurality of advertisements from a plurality of advertisers;

See at least "...server containing a plurality of advertisements..." Pg 9 lines 10-15 See also "...the operation of the prime space manager is based on a set of contracts that were accepted when the advertisers placed their advertisements with the system..." Pg 16 lines 20-25

storing revenue information that indicates potential revenue amounts for the plurality of advertisements, wherein each of the plurality of advertisements is associated with corresponding delivery criteria and a corresponding contract of a plurality of contracts;

See at least "...Let  $P_1 \dots P_n$  denote the contract values associated with the corresponding advertisements ( $P_1$  denotes the contract value associated with advertisement  $A_i$ , as a function of the price paid by the advertiser)..." Pg 47 lines 17-21 See also abstract "...the advertisements can be made to satisfy a set of constraints requested by the advertiser as well as the constraints of the publisher of the page..." See also Page 5 lines 10-15

wherein the plurality of contracts includes the first contract and the second contract;

"...contracts..." pg 6 lines 15-21

wherein the plurality of advertisers includes the first advertiser and the second advertiser;

"...advertisers..." pg 6 lines 15-21

receiving, from a client that is not one of the plurality of advertisers, a request to provide over the network a piece of electronic content that includes a slot for an advertisement;

See at least abstract "...the advertisements can be made to satisfy a set of constraints requested by the advertiser as well as the constraints of the publisher of the page..." See also Page 5 lines 10-15 See also "...for purposes for the present invention, it is assumed that here are three broad classes of publishers that can utilize the advertising features of the present invention. A publisher can include virtually anyone that provides content to the network..." Pg 21 lines 5-10 See also "...the purpose of the mixer is to take publishers' content and advertisements and combine them together so that the content and the advertisements are mixed on the same page..." Pg 32 lines 10-16 See also "...no advertisements are shown unless it can be determined that the advertisements are in some way focused or related to the content of what the user requested..." Pg 27 lines 5-10

and in response to receiving the request, the steps of: one or more computing devices comparing slot attributes of the slot with the delivery criteria of the plurality of advertisements to determine a first subset of the plurality of advertisements that qualify for inclusion in the slot, wherein the slot attributes of the slot include at least one of (a) the nature of the piece of electronic content, (b) the size of the slot within the piece of electronic content, or (c) the placement of the slot within the piece of electronic content;

See at least "...no advertisements are shown unless it can be determined [comparing slot attributes of the slot with the delivery criteria] that the advertisements are in some way focused [nature] or related to the content of what the user requested..." Pg 27 lines 5-10 See also "...the layout manager evaluates each and every rule in its rule base to figure out which rule is the best for a given piece of data. The rules are evaluated at step 54 by calculating a meta and a target function cost. The meta template is the template that describes what the

layout is about. For example, the template may provide that there are only five places [placement of the slot within the piece of electronic content] for advertisements in a particular layout..." Pg 30 lines 8-15 See also "...the variables that are expressed in the rules are based on a number of parameters including the size of the text, the amount of text, the size of the maps, the size of the images, and the size of the advertisement..." Pg 13 lines 10-15 See also "...The prime space manager has a prime space algorithm that accepts as inputs the list of relevant ads that are related to the query at hand, the size of the prime space, [size of the slot within the piece of electronic content] and the list of all ad contracts. The prime space manager then looks at all the ad contracts and determines which advertisements to show to the user..." Pg 46 lines 24-30 See also "...server..." pg 9 lines 10-20 See also "...filters..." [subsets] pg 47 lines 5-7

the one or more computing devices creating a second subset of advertisements by filtering, out of the first subset, advertisements whose delivery obligations are on track to be satisfied;

See at least "...no advertisements are shown unless it can be determined that the advertisements are in some way focused or related to the content of what the user requested..." Pg 27 lines 5-10, See also "...displays the content pages with focused, targeted advertisements as part of the page..." abstract See also "...advertisements are more focused and targeted..." Pg 3 lines 22-27 See also "...the advertisements can be made to satisfy a set of constraints by the advertiser, as well as the constraints of the publisher of the page..." Pg 5 lines 10-15 See also "...no advertisements are shown unless it can be determined [filtering] that the advertisements are in some way focused or related to the content of what the user requested..." Pg 27 lines 7-10 See also "...advertisers will be assured of "fair"



[filtered treatment] in the sense that their advertisements will be presented to targeted users in a manner that is commensurate with the fees they were charged. Fairness means equal access as well as controlled access ensuring that advertisers who pay more are more accessible than those who pay less [lower priority class]..." Pg 48 lines 4-10 See also "...the fairness guarantees of an algorithm for the system ensures that the advertisements are displayed in a way that is proportional to the fee charged for that advertisement..." Pg 54 lines 1-31 "...prioritize..." pg 16 lines 14-16 "...if the prime space is sufficient to hold only two ads [first subset], it is impossible to guarantee 100% ratio for more than two ads [second subset]..." Pg 7 lines 7-11

wherein the second subset includes a first advertisement associated with the first contract and a second advertisement associated with the second contract;

"...prioritize..." pg 16 lines 14-16 "...if the prime space is sufficient to hold only two ads [first subset], it is impossible to guarantee 100% ratio for more than two ads [second subset]..." Pg 7 lines 7-11 See also Pg 46 lines 13-23

selecting the first advertisement from the second subset of advertisements to include in the slot based, at least in part, on the potential revenue amounts;

See at least "...advertisers will be assured of "fair" [filtered treatment] in the sense that their advertisements will be presented to targeted users in a manner that is commensurate with the fees they were charged. Fairness means equal access as well as controlled access ensuring that advertisers who pay more are more accessible than those who pay less [lower priority class]..." Pg 48 lines 4-10 See also "...the fairness guarantees of an algorithm for the system

ensures that the advertisements are displayed in a way that is proportional to the fee charged for that advertisement...” Pg 54 lines 1-31

inserting said first advertisement into the slot to create a modified piece of electronic content;

See at least “...algorithms...include Ai in the prime space...” Pg 49 line 5 – Pg 52 See also Pg 54 lines 20-30 “...display in prime space...”

delivering, as a response to the request, the modified piece of electronic content to the user.

See at least “...algorithms...include Ai in the prime space...” Pg 49 line 5 – Pg 52 See also Pg 54 lines 20-30 “...display in prime space...”

**In general, NAQVI** teaches a system and method for placing advertisements in a computer network providing for guaranteed placement which avoids late-comer problems  
**Although NAQVI** teaches a system and method for placing advertisements in a computer network providing for guaranteed placement which avoids late-comer problems, **nevertheless, NAQVI** does not expressly disclose wherein the second contract is associated with a behindness value that is currently greater than a behindness value associated with the first contract; wherein the behindness value of each contract reflects how far behind a content provider is on satisfying the delivery obligations associated with each contract;  
**HOWEVER, HOROWITZ** does teach wherein the second contract is associated with a behindness value that is currently greater than a behindness value associated with the first contract;  
wherein the behindness value of each contract reflects how far behind a content provider is on satisfying the delivery obligations associated with each contract;

(See at least HOROWITZ "...throttle value..." [0076] see also guaranteed placement Fig 8 and [0063])

**THEREFORE**, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have combined the teachings of HOROWITZ with NAQVI so as to provide an advertising delivery system that provides for measuring how on track a campaign is while also providing for guaranteed placement **thereby** preventing competitors from over-booking advertisements in an effort to become further behind and thus have their advertisements shown first in order to guarantee to an advertiser that when they contract for advertisements that they will have a reasonable assurance that the advertisements will be displayed in a timely manner producing predictable results.

As per Claims 2 and 9: NAQVI and HOROWITZ teach: claims 1 and 8 as discussed above NAQVI further discloses: wherein: each advertisement of the plurality of advertisements has a corresponding delivery obligation and a corresponding potential revenue amount.

See at least abstract "...the advertisements can be made to satisfy a set of constraints requested by the advertiser as well as the constraints of the publisher of the page..." See also Page 5 lines 10-15

As per Claims 3 and 10: NAQVI and HOROWITZ teach: claims 2 and 9 as discussed above NAQVI further discloses: wherein the selecting the advertisement to include further comprises: selecting the first advertisement instead of the second advertisement if the corresponding potential revenue amount of the first advertisement is higher than the corresponding potential revenue amount of the second advertisement.

See at least "...advertisers will be assured of "fair" [filtered treatment] in the sense that their advertisements will be presented to targeted users in a manner that is commensurate with the fees they were charged. Fairness means equal access as well as controlled access ensuring that advertisers who pay more are more accessible than those who pay less [lower priority class]..." Pg 48 lines 4-10 See also "...the fairness guarantees of an algorithm for the system ensures that the advertisements are displayed in a way that is proportional to the fee charged for that advertisement..." Pg 54 lines 1-31

As per Claims 5 and 12: NAQVI and HOROWITZ teach: claims 1 and 8 as discussed above  
NAQVI further discloses: wherein the piece of electronic content is a web page.

See at least "...web..." Pg 2 line 10; See also "...content page..." Pg 9 lines 15-20

As per Claims 6 and 13: NAQVI and HOROWITZ teach: claims 1 and 8 as discussed above  
HOROWITZ further discloses: wherein the piece of electronic content is a video stream. See at least [0111]

**THEREFORE**, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have combined the teachings of HOROWITZ with NAQVI so as to provide a system and method for providing content, ie video stream and advertisements to users of the internet **thereby** allowing advertisers and publishers target market audiences who are interested in particular types of content and serve them with similar advertisements so as to maximize advertising dollars and have more effective advertising campaigns.

As per Claims 29 and 32: NAQVI and HOROWITZ teach: claims 1 and 8 as discussed above NAQVI further discloses: further comprising: exclusively offering a first portion of an inventory, of advertisement slots in electronic content, to buyers that satisfy a set of criteria; and offering a second portion of the inventory to buyers that are not required to satisfy the set of criteria, wherein the buyers that satisfy the set of criteria and the buyers that are not required to satisfy the set of criteria are advertisers that provide advertisements. See at least "...exclusive..." pg 6 lines 20-33; pg 16 lines 25-33; pg 18 lines 5-15; pg 46 lines 13-25

As per Claims 30 and 33: NAQVI and HOROWITZ teach: claims 29 and 32 as discussed above NAQVI further discloses: further comprising: offering less than the entirety of the second portion of the inventory for purchase to the buyers that are not required to satisfy the set of criteria. See at least "...exclusive..." pg 6 lines 20-33; pg 16 lines 25-33; pg 18 lines 5-15; pg 46 lines 13-25

As per Claims 31 and 34: NAQVI and HOROWITZ teach: claims 30 and 33 as discussed above NAQVI further discloses: further comprising: setting an initial price that the buyers are allowed to bid on the second portion of the inventory. Pg 47 lines 15-25

As per Claims 35 and 36: NAQVI and HOROWITZ teach: claims 1 and 8 as discussed above NAQVI further discloses: further comprising: associating each of the plurality of advertisements with a priority class, wherein the priority class associated with each of the plurality of advertisements indicates whether the corresponding advertisement is the subject of a guaranteed

contract; wherein creating the second subset further includes filtering, out of the first subset, advertisements that have a priority class that is lower than the priority class of any other advertisement that belongs to the first subset. See at least “...it is a further object of the present invention to provide a method and system for advertising in which advertisers can be guaranteed that their advertisements will be displayed a certain number of times or in a particular manner or under particular circumstances...” Pg 3 line 30 – Pg 4 line 4 See also “...filters...” [subsets] pg 47 lines 5-7 See also “...advertisers will be assured of “fair” [filtered treatment] in the sense that their advertisements will be presented to targeted users in a manner that is commensurate with the fees they were charged. Fairness means equal access as well as controlled access ensuring that advertisers who pay more are more accessible than those who pay less [lower priority class]...” Pg 48 lines 4-10 See also “...the fairness guarantees of an algorithm for the system ensures that the advertisements are displayed in a way that is proportional to the fee charged for that advertisement...” Pg 54 lines 1-31

### ***Response to Arguments***

7. Applicant's remarks of 3/31/2009 are based on the newly amended claims and such arguments are fully addressed in the present Office Action as featured above. Necessitated by amendment, new grounds of rejection were made. Claim amendments overcame previous claim objections raised in office action of 2/4/2009.

Applicant contends that NAQVI fails to teach or suggest accepting the second contract after accepting the first contract. Applicant supports this argument by referring to the pending applications specification and ¶0016. Examiner reminds Applicant that limitations from the specification are not to be read into the claims. Applicant admits that NAQVI solves the “late-

comer” problem, although as addressed in the §112 ¶2 rejection above, Applicant’s claims are unclear and Examiner is not certain of Applicant’s use of the behindness value. Further, NAQVI offers guaranteed contracts which solves the “late-comer” problem. Also, NAQVI offers contracts to exclude competitor’s ads from being displayed with an advertiser’s ad. Examiner reminds Applicant that claims are interpreted with broadest reasonable interpretation. NAQVI discloses accepting the second contract after accepting the first contract as NAQVI offers several different types of contracts of varying scope. NAQVI allows for a first advertiser with a first advertisement to contract for advertising and it also allows for a second advertiser with a second advertisement to contract for advertising.

Applicant also contends that NAQVI fails to teach or suggest that a first ad is selected over a second ad despite the fact that the contract associated with the second ad has a greater behindness value than the contract associated with the first ad. As already discussed, NAQVI offers guaranteed contracts which, despite behindness value, these advertisements will be displayed. Also, the behindness values importance is unclear because advertisements are displayed at least in part on the potential revenue amounts.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Merriman et al (5,948,061) provides for “Method of Delivery, Targeting, and Measuring Advertising over Networks” in which a satisfaction index is discussed which measures how far behind or on schedule an advertisement is running.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. STIBLEY whose telephone number is (571) 270-3612. The examiner can normally be reached on Mon. - Fri. 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT WEINHARDT can be reached on (571) 272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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